

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/550,558 Confirmation No. : 1877
First Named : Christian HAMON
Inventor
Filed : 08/21/2006
TC/A.U. : 1797
Examiner : Yelena G. Gakh
Docket No. : 104056.B600303
Customer No. : 23911
Title : LABELING AGENTS FOR MASS SPECTROMETRY COMPRISING
TERTIARY AMINES

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 11, 2009, Applicant submits herewith the following response.

The Office has required that the present application be restricted, under 36 U.S.C. § 121, to one of the following three groups of claims:

Group I: Claims 1-22, drawn to a method for characterizing a molecule by mass spectrometry;

Group II: Claims 23-37, drawn to a mass tag reagents for labeling molecules;

Group III: Claims 38-39, drawn to a kit for purification of labeled analyte molecules.

Applicants elect, with traverse, Group II - claims 23-37, drawn to a mass tag reagents for labeling molecules.

The Office argues that Groups I-III do not relate to a single inventive concept as they lack the same corresponding technical features. The Office cites Haralambidou et al., “Effect of Distal Positional Isomerism on Peptide Fragmentation, A Comparison of Dimethylaminobenzyladene and Benzoyl Derivatives”, *Organic Mass Spectrometry*, Vol. 10, pages 683-697 (April 1975), as disclosing the N-terminal derivitization of peptide with tertiary amines for the purpose of determining the amino acid sequence by mass spectrometry. Applicants respectfully disagree.

With regard to the present invention, the mass target reagents and kits are specially adapted for use in the method for characterizing a molecule by mass spectrometry. In contrast, the tags disclosed by Haralambidou et al. are not designed to fulfill this function. Accordingly, the claims of all three groups share a special technical feature not taught by the art.

Furthermore, Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants’ overall invention is significantly outweighed by the public’s interest in not having to obtain and study separate patents in order to have available all of the issued patent claims covering Applicants’ invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the three inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to

independent or distinct inventions.” Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

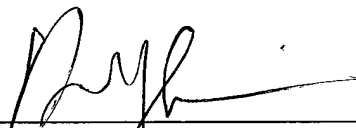
Applicant has no intention of abandoning any non-elected subject matter, and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

Applicants earnestly solicit favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 104056.B600303).

Respectfully submitted,

July 13, 2009



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